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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 403104-A-01-US (Orbach)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on <u>01/06/2007</u> Signature <u>John C. Moran</u> Typed or printed name <u>John C. Moran</u>		Application Number 10/810,526	Filed 03/27/2004
		First-Named Inventor Julian James Orbach	
		Art Unit 2617	Examiner Doan, Kiet M.
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>John C. Moran</u> Signature	
<input type="checkbox"/>	applicant/inventor.	<u>John C. Moran</u> Typed or printed name	
<input type="checkbox"/>	assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)		
<input checked="" type="checkbox"/>	attorney or agent of record. Registration number <u>30,782</u>	<u>303-450-9926</u> Telephone number	
<input type="checkbox"/>	attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____	<u>01/06/2007</u> Date	
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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Patent Application

Inventor Julian James Orbach

Atty. Docket No. 403104-A-01-US (Orbach)
Serial No. 10/810,526 Group Art Unit 2617
Filing Date 03/27/2004
Examiner Doan, Kiet M.
Title Method and Apparatus For Incoming Call Pause Notification

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COMMISSIONER FOR PATENTS
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

SIR:

Applicant respectfully request that a panel of Examiners formally review the legal and factual basis of the rejections in the Final Office Action mailed 09/08/2006 and Advisory Action mailed 12/07/2006, related to the above-identified patent application. The instant request is being filed with a Notice of Appeal in compliance with 37 §CFR 41.31. Also, the instant request is being filed prior to the filing of an appeal brief.

Applicant respectfully asserts that the above-noted rejections are factually deficient, and requests the application be allowed on the existing claims, or alternatively, that a prosecution on the merits be reopened. If the application is not allowed on the existing claims, then proposed changes which the review panel may have for Applicant which, if accepted, may result in an indication of allowability for the contested claims, would be appreciated.

GROUND OF REJECTION TO BE REVIEWED

The grounds of rejection to be reviewed are whether claims 1, 2, 4, 6-7, 12-13, 15, 17-18, 23-24, 26, 28-29, 34-35, 37, 39-40, 45-46, 48, 50-51, 56, and 59-60, are

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patentable under 35 U.S.C. §103(a) over U.S. Patent Application Publication No. 2004/0198461 of D.J. Coombes (hereafter referred to as Coombes) in view of U.S. Patent No. 6,216,016 of G.T. Cronin (hereafter referred to as Cronin). In addition, whether claims 3, 25, and 47, are patentable under 35 U.S.C. §103(a) over Coombes in view of Cronin and further view of U.S. Patent No. 6704,565 of W.G. Parson, et al. (hereafter referred to as Parson). Also, whether claims 8, 10-11, 19, 21, 22, 30, 32, 33, 41, 43-45, 52, 54, 55, 57, and 58, are patentable under 35 U.S.C. §103(a) over Coombes in view of Cronin and further view of Parson. Finally, whether claims 61-63 are patentable under 35 U.S.C. §103(a) over Coombes in view of Parson and further view of Cronin.

ARGUMENT

Rejection of Claims 1, 4, 6, 7, 11 23, 24, 26, 28, 29, 46, 48, 50, 51, 59, and 60 under 35 U.S.C. §103(a) over Coombes in view of Cronin

The Examiner stated that the steps of "receiving a time specifying the delay from the user after the incoming call is received", "inserting the time into a predefined message", and transmitting the predefined message are taught by Cronin (page 2, Advisory Action). The first text cited by the Examiner does indeed describe a predefined message but does not disclose or suggest receiving a time specifying the delay from the user after the incoming call is received and inserting the time into the predefined message. Rather, Cronin discloses the periodic transmission of a predefined message (waiting message) at some fixed interval to the calling party (Column 1, lines 34-61). In particular, this cited text clearly states:

The device comprises message generation means for generating a waiting message intended for the calling party, that the device comprises first initiating means for initiating periodic transmission of the waiting message to the calling party... Herewith, the calling party is informed that his call is being answered and that the called party wants to talk to him after a relatively short waiting.... Because of the receiving the message periodically, the calling party is aware of the fact that the called party's telecommunication device is on hold and that his call most likely will be answered... The waiting message could have the contents "please wait a moment", "please, wait a moment, I am going to find a more suitable room for answering your call", or the like, and could be repeated every 20 or 30 seconds, for instance.

The second cited text at Column 4, lines 45-54, and the third cited text at Column 5, lines 1-60, simply describes with respect to Figure 4 and Figures 5 and 6, respectively, how the operations described in the first cited text would be performed

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There is no disclosure or suggestion of receiving a time specifying the delay from the user after the incoming call is received and inserting that time into the predefined message in the above cited text.

Applicant respectfully submits that claim 1 is patentable under 35 U.S.C. §103(a) in view of the cited art. Dependent claims 4, 6, 7, 11 and 60 are directly or indirectly dependent on claim 1 and are patentable for at least the same reasons as set forth with respect to claim 1.

Independent claim 23 and dependent claims 24, 26, 28, and 28, and independent claim 45 and dependent claims 46, 48, 50, and 51, are patentable for at least the same reasons as claims 1, 4, 6, 7, and 11.

Rejection of Claims 3, 25, 47, 61, 62, and 63 under 35 U.S.C. §103(a) over Coombes in view of Cronin and further in view of Parson

With respect to the step of "terminating the incoming call after transmission of the message" in claim 3, the Examiner states that this is disclosed in Column 2, lines 60-67 and Column 3, lines 1-28. What the text at Column 2, lines 60-67, states is:

The on-hold message service system 200 provides a holding party, such as a party using wireless telephone 300, with a way to terminate an on-hold call will leaving a message for the hold initiating party, such as the party using the second telephone 400. The on-hold message service could be offered, for example, as a feature by the communication network provider. Communication network providers typically offer an array of communication

However, claim 3 clearly recites that the called telecommunication terminal performs the steps of answering, muting, transmitting a message, and terminating the incoming call after transmission of the message. Parson does not disclose or suggest this since in Parson it is the calling telecommunication terminal (wireless telephone 300) that is sending a message and terminating the call.

Applicant respectfully submits that claim 3 is patentable under 35 U.S.C. 103(a) over the cited art. Dependent claim 61 is directly dependent on claim 3 and is patentable for at least the same reasons as claim 3. Applicant respectfully submits that claims 25, 47, 62, and 63 are patentable for on correct that the same reasons as claims 3 and 61.

Rejection of Claims 12, 13, 15-18, 23, 24, 26, 28, 29, 46, 48, 50, and 51 under 35 U.S.C. §103(a) over Coombes in view of Cronin

The rejection of claim 12 is respectfully traversed. Claim 12 recites in part "answering the incoming call by the wireless handset in response to a predefined

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amount of movement of the wireless handset...." Coombes, Cronin, and Parsons do not disclose or suggest singularly or in combination the answering of an incoming call upon a predefined amount of movement of the handset being detected. Present claim 12 no longer recites "in response to one of at least an input from the user or a predefined amount of movement"; rather, present claim 12 now recites "in response to a predefined amount of movement". Hence, applicant does not understand the Examiner's statement of "therefore, Examiner interprets 'answering the incoming call by the wireless handset in response to one of at least an input from the user' as broadest reasonable interpretation and it is proper." (See Advisory Action, page 4.) Present claim 12 is now similar to claim 56. In rejecting claim 56, the Examiner stated on page 4 of the Final Office Action "means for detecting movement of the communication terminal; and means for transmitting a message to the calling party upon detection of the incoming call and movement (Abstract, Paragraphs [0008], [0011-0012], [0014] teach mobile/terminal communication receiving call and put call on hold means as detecting movement of the communication terminal and users select message to transmit to the calling party as Fig. 2 illustrate)." However, the cited paragraphs do not disclose or suggest detecting movement of a wireless handset.

Applicant respectfully submits that claim 12 is patentable under 35 U.S.C. §103(a) over the cited references. Dependent claims 13-18 are directly or indirectly dependent on claim 12 and are patentable for at least the same reasons as claim 12.

Claims 34, 35, and 37-40 are patentable for the same reasons as claims 13-18.

Claim 56 is patentable for the same reasons as claim 12.

Rejection of Dependent Claims 8, 10, 11, 19, 20-22, 30, 32, 33, 36, 41-44, 52, 54, 55, 57, and 58 under 35 U.S.C. §103(a) over Coombes in view of Cronin and further in view of Parson

Dependent claims 8, 10, 11, 19, 20-22, 30, 32, 33, 36, 41-44, 52, 54, 55, 57, and 58 are directly or indirectly dependent on independent claims that have been shown in the preceding paragraphs to be patentable over the cited references since for these dependent claims Parson was only cited as disclosing text messaging. Hence, dependent claims 8, 10, 11, 19, 20-22, 30, 32, 33, 36, 41-44, 52, 54, 55, 57, and 58 are patentable for at least the same reasons as their independent claims.

Summary

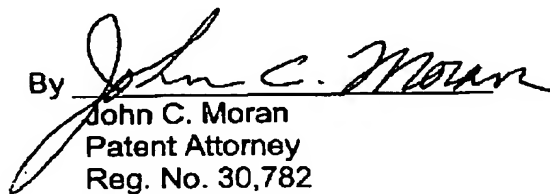
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For the foregoing reasons, applicant respectfully request that the present application be allowed, or alternatively, that prosecution on the merits be reopened.

Respectfully,

Julian James Orbach

By


John C. Moran
Patent Attorney
Reg. No. 30,782
303-450-9926

Date:

01/06/2007

John C. Moran, Attorney, P.C.
4120 115th Place
Thornton, CO 80233